

5/18/01

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF  
THE TTAB

Paper No. 11  
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

---

Trademark Trial and Appeal Board

---

In re MicroStrategy Incorporated

---

Serial No. 75/451,045

---

Michael J. Bevilacqua and Barbara A. Barakat of Hale and Dorr LLP for MicroStrategy Incorporated.

Robin S. Chosid, Trademark Examining Attorney, Law Office 102 (Thomas V. Shaw, Managing Attorney).

---

Before Chapman, Bucher and Holtzman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On March 16, 1998, MicroStrategy Incorporated filed an application, based on Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), to register the mark DSS BROADCASTER on the Principal Register for the following goods, as amended: "computer software for on-line analytical processing and data analysis, namely, processing and analyzing data for the purpose of delivering customized and personalized information to targeted recipients" in International Class 9. Applicant filed, on October 6, 1998, an amendment to allege use (which was accepted by the Office), asserting

dates of first use and first use in commerce of August 11, 1998.

The Examining Attorney refused registration on the ground that the term DSS BROADCASTER, when applied to the identified goods, is merely descriptive of the goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C.

§1052(e)(1). The Examining Attorney also required a disclaimer of "DSS."

When both the refusal and the disclaimer requirement were made final, applicant appealed to this Board. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

Preliminarily, we note that the Examining Attorney who wrote the brief on appeal withdrew the requirement for a disclaimer (brief, footnote 3, p. 3). Thus, the only issue before the Board is whether applicant's mark is merely descriptive under Section 2(e)(1) of the Trademark Act.

The Examining Attorney contends that the term DSS BROADCASTER is merely descriptive of a central feature of applicant's computer programs, specifically disseminating or broadcasting information; that "DSS" means "decision support system" and "broadcast" means "to disseminate information to several recipients simultaneously"; and that

the combination of "DSS" and "BROADCASTER" does not create a separate, non-descriptive term.

In support of her position, the Examining Attorney submitted the dictionary definition of "broadcast" set forth above, as well as the following definition of "DSS," both from The Computer Glossary: The Complete Illustrated Dictionary (Seventh Edition 1995):

"1. (Decision Support System) An information and planning system that provides the ability to interrogate computers on an ad hoc basis, analyze information and predict the impact of decisions before they are made.

DBMSs let you select data and derive information for reporting and analysis. Spreadsheets and modeling programs provide both analysis and 'what if?' planning. However, any single application that supports decision making is not a DSS. A DSS is a cohesive and integrated set of programs that share data and information. A DSS might also retrieve industry data from external sources that can be compared and used for historical and statistical purposes.

An integrated DSS directly impacts management's decision-making process and can be a very cost-beneficial computer application. See EIS.

2. (Digital Signature Standard) A National Security Administration standard for authenticating an electronic message. See RSA and digital signature."

The Examining Attorney also submitted 27 excerpted stories as representative of the 153 stories found in the

Nexis database "in which information about the applicant's goods appeared." (First Office action dated February 22, 1999, p. 2). Some examples thereof follow (emphasis added):

Headline: Braced to best Microsoft, others, MicroStrategy helps firms navigate data  
A new product, **DSS Broadcaster**, will distribute information more cheaply to the mass business market via wireless pagers, pagers, fax machines and other..., "USA Today," February 17, 1999;

Headline: MicroStrategy helps Lexis-Nexis better serve its customers  
...Lexis-Nexis is currently evaluating MicroStrategy's **DSS Broadcaster**, the industry's first Information Broadcast Server, so that pertinent customer information can be distributed to several output devices, including, ... MicroStrategy, DSS Suite, DSS Agent, DSS Web, and **DSS Broadcaster** are either trademarks or registered trademarks of MicroStrategy Incorporated in the United States and certain other countries....., "M2 Presswire," January 21, 1999;

Headline: MicroStrategy **DSS Broadcaster** wins The Data Warehouse Institute's Pioneering Products Shoot-Out  
...Innovative New Product Set to Redefine E-Business Market.  
MicroStrategy demonstrated **DSS Broadcaster's** innovative ability to deliver personalized broadcasts, complete with sophisticated analyses derived from a relational database, to several output devices including email, pager, and mobile phone. **DSS Broadcaster** alerts users to important

business events via existing and emerging communication channels, only notifying users when pre-determined business conditions are met. With timely receipt of useful information, **DSS Broadcaster** enables users at the departmental, enterprise, supply chain, and even consumer levels to make better decisions. Any company that uses **DSS Broadcaster** can transform itself into an e-business...., "M2 Presswire," November 10, 1998;

Headline: MicroStrategy named a premier member of IBM's Solution Developer Program

MicroStrategy's latest product, **DSS Broadcaster**, helps businesses maximize their investments in data warehouses and communication devices, such as email, fax, pager and mobile phone. As the industry's first Information Broadcast Server, **DSS Broadcaster** delivers personalized analysis from data warehouses to common business media on a time or event triggered basis. By delivering personalized information from a DB2 Universal Database data warehouse to users, **DSS Broadcaster** helps organizations leverage their IBM software and hardware investments while extending access to information throughout and beyond the enterprise...., "M2 Presswire," November 10, 1998; and

Headline: MicroStrategy announces support for HP's new HP 9000 V2500 enterprise server

... a member of HP's Open Warehouse alliance program, extended the reach of the data warehouse even further by delivering **DSS Broadcaster**, the industry's first Information Broadcast Server that leverages established and emerging communication channels to extend access to information throughout

the enterprise and beyond. Through the delivery of e-broadcast servers via e-mail, fax, pager and mobile phone, **DSS Broadcaster** is enabling organizations to target an entirely new group of users to their data warehouses. The applications require highly available systems and ..., "With the introduction of **DSS Broadcaster**, MicroStrategy customers need the right infrastructure to broadcast information throughout and beyond large organizations. Our joint customers will find that the ..., "M2 Presswire," December 9, 1998.

In addition, the Examining Attorney relies on applicant's uses of the terms "broadcast(s)" and "broadcasting" appearing in applicant's website. The Examining Attorney contends that the website describes the features of applicant's product through uses such as the following: "personalize the contents of broadcast messages for each individual recipient," and "satisfy specialized requirements and customize each broadcast message."

Applicant urges reversal on the basis that the Examining Attorney improperly dissected the mark rather than considering the mark as a whole in determining descriptiveness; that there is nothing about the mark taken as a whole which would enable potential purchasers to immediately understand the precise nature or the intended function of applicant's goods; that the acronym "DSS" refers to things other than "decision support system," such

as "digital signature standard," "digital satellite system," "data storage set" and "document storage system"<sup>1</sup>; that the terms DSS (which can refer to different things) and BROADCASTER (when taken in the normal meaning related to "broadcast" as defined in the computer dictionary), taken together, do not describe applicant's product or its function because "a decision support system is not information and a decision support system is not disseminated to several recipients" (applicant's response, July 19, 1999, p. 4); that the purchasing public will have to use imagination, thought and perception to ascertain the nature of applicant's product (which "allow its purchasers to disseminate information to others on an individualized basis" (applicant's response, July 19, 1999, p. 5); that the mark is at most, suggestive, not merely descriptive, of applicant's product; and that all of the excerpted Nexis stories submitted by the Examining Attorney were about applicant's involved product, and do not establish that the

---

<sup>1</sup> Applicant referred in its brief (p. 5) to attached entries from two different website resources, one glossary and one acronym server, but there are no such attachments in the record. However, we take judicial notice of the Acronyms, Initialisms & Abbreviations Dictionary (28th ed. 2001), which includes all of the meanings listed above as well as numerous others. See TBMP §712.01.

term DSS BROADCASTER is merely descriptive of the involved goods.<sup>2</sup>

The test for determining whether a mark is merely descriptive is whether the mark forthwith conveys an immediate idea concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). Moreover, the immediate idea must be conveyed with a "degree of particularity." *In re TMS Corporation of the Americas*, 200 USPQ 57, 59 (TTAB 1978). See also, *In re Entenmann's Inc.*, 15 USPQ2d 1750, 1751 (TTAB 1990), *aff'd*, *unpub'd*, Fed. Cir. February 13, 1991. As the Court stated in *In re Abcor Development*, supra: "Although a mark may be generally descriptive, if it also functions as an indication of origin, it is not 'merely descriptive.'" See

---

<sup>2</sup> Applicant also referred in its brief (pp. 6-7) to attached copies of numerous third-party registrations wherein disclaimers of "DSS" were not generally required by the USPTO. Again, these attachments were not enclosed with the brief. However, the photocopies of third-party registrations are not necessary to our decision herein because the Examining Attorney has withdrawn the requirement for a disclaimer of "DSS."

We note that even if the photocopies of third-party registrations had been attached to applicant's brief, they would be untimely filed under Trademark Rule 2.142(d), and the Examining Attorney properly objected thereto (brief, footnote 6, p. 5). Thus, the material would not have been considered by the Board.



also, *In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 205 USPQ2d 505 (CCPA 1980). Whereas, a mark is suggestive if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. See *In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 205 USPQ2d 505 (CCPA 1980).

It is also well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the term or phrase is being used on or in connection with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services. See *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991).

Viewing this record in its entirety, we find that the Examining Attorney has not established a prima facie showing that the mark DSS BROADCASTER, taken as a whole, is merely descriptive of applicant's "computer software for on-line analytical processing and data analysis, namely, processing and analyzing data for the purpose of delivering customized and personalized information to targeted recipients." While it is true that DSS is an acronym for "decision support system" (as well as being an acronym for

several other things), and that meaning may be the most relevant to applicant's involved goods, nonetheless, the Examining Attorney has not established how the acronym DSS coupled with the word BROADCASTER immediately and forthwith conveys descriptive information about a significant feature of applicant's involved goods.

Applicant's use in its website of the general terms "broadcast(s)" or "broadcasting" does not establish that DSS BROADCASTER is merely descriptive of the involved computer software. See *In re Hutchinson Technology Inc.*, 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988) (wherein the Court majority's discussion of the term "technology" was within the context of whether the mark HUTCHINSON TECHNOLOGY was primarily merely a surname, but the Court stated "the fact that the term 'technology' is used in connection with computer products does not mean that the term is descriptive of them. Many other goods possibly may be included within the broad term 'technology'"). In fact, applicant's website reveals that applicant consistently uses "DSS Broadcaster[tm]" and "DSS Broadcaster" throughout the website. That is, applicant does not use the term descriptively within its website.

All of the Nexis excerpts submitted by the Examining Attorney utilize DSS BROADCASTER as a trademark and all

clearly treat the term as applicant's trademark, and some of the stories explicitly refer to DSS BROADCASTER as applicant's trademark.

As stated previously, the burden of establishing a prima facie case that applicant's mark is merely descriptive of the involved goods rests with the Examining Attorney. In this case, the Examining Attorney did not submit any evidence whatsoever demonstrating the descriptive nature of "DSS BROADCASTER," as a whole, for the identified goods.

Of course, if doubt exists as to whether a term is merely descriptive, it is the practice of this Board to resolve doubt in favor of the applicant and pass the application to publication. See *In re The Stroh Brewery Co.*, 34 USPQ2d 1796 (TTAB 1995). In this way, anyone who believes that the term is, in fact, descriptive, may oppose and present evidence in an inter partes proceeding on this issue to the Board.

**Decision:** The refusal to register under Section 2(e)(1) is reversed.

\*\*\*\*\*

Bucher, dissenting:

Inasmuch as I harbor no doubts about the descriptiveness of the term DSS BROADCASTER for this

computer software, I do wish I could convince my colleagues that we should affirm the Trademark Examining Attorney. Having failed to do so, I respectfully dissent from the majority decision. Despite the thin record in the instant application, and the confusing and contradictory manner in which the Office over the past several years has dealt with applicant's various alleged marks containing the term "DSS," I conclude that the instant record, as a whole, supports an affirmance herein.

Let us look first at the term "DSS." Whether one calls it "group DSS," executive information systems (EIS),<sup>3</sup> "on-line analytical processing" (OLAP),<sup>4</sup> or knowledge discovery systems, information systems managers and business executives both understand that these can all be lumped into a catch-all category of systems called "Decision Support Systems," or "DSS." Clearly, the first dictionary definition cited in the majority opinion demonstrates that the term "Decision Support System," and its initialism "DSS," continue to be useful and inclusive terms for many types of information systems that support decision-making. In fact, in the context of the identified goods, the term "DSS" is a generic designation, and cannot

---

<sup>3</sup> See dictionary definition, *supra*, p. 3.

<sup>4</sup> See applicant's identification of goods, *supra*, p. 1.

be considered as proprietary to MicroStrategy Incorporated. Notwithstanding applicant's arguments that these goods do not comprise a "Decision Support System," the evidence in the file shows that applicant's *"on-line analytical processing"* software is touted as enabling "... users at the departmental, enterprise, supply chain, and even consumer levels to make better decisions."<sup>5</sup> Further, considering the LEXIS/NEXIS® evidence and applicant's own web pages, one can find references to all the essential components of any enterprise-wide data delivery architecture, i.e., operational data, data warehouses, networks, DSS engines, and this specific DSS application.<sup>6</sup>

In fact, turning next to the term "Broadcaster," we learn that the specific DSS application involved herein is an "information broadcast server." This state-of-the-art application development environment takes tasks formerly assumed to be white-collar work (i.e., writing letters, sending electronic mail messages or issuing requests for more detailed information) and turns the tasks into automated activities that directly follow computerized

---

<sup>5</sup> See "M2 Presswire," November 10, 1998, *supra*, p. 5.

<sup>6</sup> While applicant's specimens of record (e.g., compact discs) include the somewhat different words "Decision Support Solutions," it would be disingenuous of applicant or this Board to conclude that a generally understood initialism for a generic term can be transformed into a source-indicator with such a clever substitution.

decision support investigations. The record shows that "e-broadcast servers" are delivering customized and personalized "broadcast messages." That is, the computer system is actually "broadcasting information" to targeted recipients, throughout the enterprise and beyond. The DSS application does this via existing and emerging communication channels such as e-mail, pagers, fax machines, mobile telephones, and the like.

I take judicial notice of the fact that "broadcaster" is a noun for one who disseminates information over a wide area, or to several recipients simultaneously. This definition is not limited to whether the disseminator is, for example, a television station, an individual having a loud voice or an "information broadcast server." Furthermore, to the extent that the decision of Hutchinson Technology Inc., *supra*, is even applicable to a discussion under Section 2(e)(1) of the Act, "broadcaster" for an information *broadcast* server has a great deal more "particularity" than does a broad term like "technology" for computer products generally.

Finally, as does the majority, I must consider whether the combination of the generic term "DSS" and the descriptive, if not generic term, "Broadcaster," creates any new or incongruous meanings. To the extent one can

conclude that applicant's revolutionary software is a "decision support system," or "DSS," whose primary, innovative feature is an information broadcast server, or "broadcaster," I find nothing new or incongruous in the combination. This alleged mark, taken as a whole, would enable potential purchasers, i.e., those who are knowledgeable about on-line analytical processing, readily and immediately to understand the precise nature or the intended function of applicant's goods. Following this logic, presumably anyone else in the information systems industry, whose decision support system architecture permits a broadcasting application should also be able to employ this combined term using the ordinary dictionary meanings of both of the constituent elements.